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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,858	02/25/2000	MAIWENN BONNET	32143-152042	7234

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EXAMINER

LEWIS, RALPH A

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/423,858</b>	Applicant(s) <b>Bonnet et al</b>
	Examiner <b>Ralph Lewis</b>	Art Unit <b>3732</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on Nov 21, 2002

2a)  This action is **FINAL**.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 1-28, 32-34, and 37-42 is/are pending in the application.

4a) Of the above, claim(s) 25 and 26 is/are withdrawn from consideration.

5)  Claim(s) 27 and 28 is/are allowed.

6)  Claim(s) 1-24, 32-34, and 37-42 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      6)  Other: \_\_\_\_\_

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### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24, 32-35 and 37-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear to the examiner what the limitation “does not present a revolution axis” is in reference to. The “revolution axis” terminology does not appear to be present (i.e. defined) in the specification.

In claims 1 and 42, the limitation “shape as close as possible to a predetermined final form” is indefinite as it is unclear what is meant by the standard “as close as possible.” It would seem to the examiner that the shape “as close as possible” to the final form would be the final form since the final form is “is possible.” Moreover, it is noted that dependent claim 2, calls for the shape to be “tubular or approximately tubular.”

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-8, 33, 34, 41 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Strassheimer (4,785,948).

Strassheimer discloses a thermoplastic preform (note Figures 1, 2) having variable wall thickness. It is unclear what the limitation “does not present a revolution axis” is in reference to, however, the examiner interprets the language as requiring asymmetrical structure about a central axis. As illustrated in Figures 2, 9 and 10 of Strassheimer, the preform is asymmetrical about a central axis. The particular shape which applicant intends for the preform to be molded into fails to impose any objectively ascertainable structural distinctions from the preform disclosed by Strassheimer. Applicant is not entitled to patent on a known prior art piece of plastic, simply because applicant intends for that known prior art piece of plastic to be molded into some new shape.

The limitation “as close as possible to a predetermined final form” is not understood. It is suggested that applicant define the “close as possible shape” with structural limitations directed to the shape. The examiner readily admits that the preform shape of applicant’s Figures 2A-2C is significantly different from the prior art and certainly appears patentable, applicant is encouraged to positively claim that shape.

Applicant has argued in the past that the preamble limitation that the claimed preform is “for obtaining a personalized orthopedic or dento-facial orthopedic apparatus” inherently requires limitations regarding size and biocompatible materials. The examiner agrees, and asserts that the Strassheimer preform inherently meets such broad and undefined inherent limitations.

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Claims 8, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art of a Bonnet's Nighttime Lingual Envelope.

Applicant's admits that Bonnet's Nighttime Lingual Envelope is well known prior art having been developed after the publication of the examiner's dentistry dictionary. Merely setting forth a new process to make an old and known prior art device fails to make the old prior art apparatus itself patentable.

Applicant argues that the prior art does not teach or suggest that the claimed preform could be used to form a Bonnet's Nighttime Lingual Envelope. The examiner agrees and notes that the present claims are interpreted as being directed to the Bonnet's Nighttime Lingual Envelope which is an admitted prior art device, not the preform. If the claims are only directed to a preform that is intended to be formed into a Bonnet's Nighttime Lingual Envelope, then they are anticipated by the Strassheimer preform as rejected above. The examiner is covering either interpretation of the claims.

### **37 CFR 1.32 Declaration**

Applicant submitted a 1.32 declaration which the remarks indicate as being "an unexecuted copy," however, the received copy appears to have been signed. It appears as though applicant later obtained an executed declaration, but neglected to change the remarks. The examiner is treating declaration as though it was properly executed. If it was not, applicant is encouraged to forward properly executed declaration.

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The examiner has carefully reviewed the 1.32 decalaration and is in full agreement with it. The examiner agrees that applicant has present patentable subject matter and has indicated many of the claims to be allowable. With regard to the rejected claims, however, the scope set forth reads on the prior art as applied in the rejections. These claims are too braodly worded.

### **Allowable Subject Matter**

Claims 27 and 28 are allowed.

Claims 9-24, 32, 35 and 37-40 would be allowable if rewritten to over come the rejection based on 35 U.S.C. 112, second paragraph and if rewritten in independent form to include all of the limitations of the claims from which they depend.

### **Prior Art**

Uhlig (4,079,111) and Krishnakumar (5,158,817) are made of record.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(703) 308-0770**. Fax (703) 872-9302. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis  
February 10, 2003

  
Ralph A. Lewis  
Primary Examiner  
Art 3732